

Application/Control Number : 10/600,461
Art Unit: 1743
October 24, 2005
Page 6

Remarks.

Claims 1-20, of which claims 1, 8 and 15 are pending in the application.

The Examiner's grounds for rejection of claims 1-20 and the cited references have been carefully considered by the Applicant.

New amendments to the claims are hereby submitted.

Reconsideration of the application as hereby amended is respectfully requested.

In relation with the Examiner's rationale from the Detailed Action intended to show readability of the limitations of claims 1-20 on Hayes and which supports the claim rejections under 35 USC § 102, the following is submitted.

The Claims

The words in claims are to be given their broadest reasonable interpretation consistent with the specification In re Finsterwalder, 436 F.2d 1028, 168 USPQ 530 (1971). The interpretation must be reasonable, since words or terms have to be given the meaning called for by the specification of which they form a part. In re Rovka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974) - MPEP 2111 - 2111.01.

It is unambiguously clear from the claim limitations (see independent claims 1, 8 and 15) and specification (see pages 3-4, lines 11-30 and 1-19, respectively) that the disposable support and the container assembly are separate entities (10 and 20 in Figure 1).

It is also clear that the disposable support with all its components is a monolithic piece molded in plastics.

It is clear again that the disposable support has assembly edges that can accommodate the container assembly comprising the separate container with flat supporting base, the slide and filter card.

Application/Control Number : 10/600,461
Art Unit: 1743
October 24, 2005
Page 7

The cited reference

It is unambiguously clear that Hayes discloses a chamber assembly 10 made of a sample chamber that is a plastic unitary body 12 (column 5, lines 17-21), with a funnel 22 and a sample holding portion 20 (see column 5, lines 36-67) that is an inclined channel chamber formed by vertical lateral walls 30 and inclined top 36 and bottom 32 walls which enclose baffle plates 38, 40, 42 parallel with the inclined bottom wall 32 and connected alternately, one to the left, one to the right side wall with opposed longitudinal edges free and with front ends 44 (see through hole in flange 24 of Figures 1, 3 and Figure 2) that are also free and not connected to flange 24.

The fact that a channel for the sample is formed that is unambiguously inclined with baffle plates 38, 40 and 42 that form "inclined ledges upon which sedimental materials will come to rest..." is also clear (see column 6, lines 3-5).

The term "inclined" as different from --horizontal-- (see also the Webster Dictionary) is mathematically and also physically definitive in view of the precise specification and flow-sedimentation function disclosed therein, which necessarily requires inclined flowing surfaces.

The filter card is only mentioned at column 1, lines 46-49 as usable only by the prior art devices to absorb the suspending fluid.

The embodiments disclosed by Hayes not only are completely silent on the interposition of a filter card between the slide 16 and the flange 24, but repeatedly and consistently disclose the sample material as "travelling directly to the portion of the slide opposite the free end 44 of the baffle plate over which it passed (column 6, lines 13-15) and that the "chamber 12 is sealed to the microscope slide 16 by means of a gasket 14...sized to cover the surface 48 of flange member 24...." and "gasket 14 surrounds the opening 28 and provides a seal when slide 16 and flange portion 24 are pressed together in the holder" (see column 6, lines 34-37, and column 7, lines 5-7).

Application/Control Number : 10/600,461
Art Unit: 1743
October 24, 2005
Page 8

Moreover, the suspending material is not absorbed by the filter card as in the criticised prior art, but instead is "discarded from the chamber or decanted in a beaker and usefor other tests".

The holder 18 (the support) is of a "conventional design with a channel shaped metal body" (see column 6, lines 47-49).

In view of the fact that, in order to anticipate, the reference must clearly and unequivocally disclose the claimed invention or direct those skilled in the art to the invention without any need for picking, choosing, and combining various disclosures not directly related to each other by the teachings of the cited reference. *In re Arkley*, 455 F.2d 586, 587, 172 USPQ 524, 526 (CCPA 1972), and that the identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990) MPEP 2131, reading of claim 1 on Hayes, as construed at par 2 of the Detailed Action, appears to lack objective basis.

Moreover:

-it is submitted that at col. 5, lines 19-21, it is not the support 18 (which is in sheet metal as set fort above) is disclosed as being in plastics but the sample chamber 12, since the whole paragraph, beginning at line 17 wholly and clearly refers to the unitary molded body of the sample chamber 12, the reference "18" or the term "holder" being only mentioned at column 6, lines 47-49);

-it is submitted that the statement of page 4, par. 4, that "the claims are not directed to monolithic" does not appear to be correct, sinse claims 8 and 15 contained already the limitation "monolithic"; and

Application/Control Number : 10/600,461
Art Unit: 1743
October 24, 2005
Page 9

-in addition to the mentioned limitations, independent claim 15, deemed anticipated by Hayes, contained also the limitation "*levers adapted for finger actuation that produces an elastic flexing motion thereof such as to move apart the clamp means for accommodating and retaining, in succession...*" not disclosed by Hayes, and which limitation, apparently, has not been cited or considered in the Examiner's rejection.

Notwithstanding the above, additional limitations to the claims have been introduced to more clearly define the invention claimed.

Eventually, it is submitted that none of the cited prior documents expressly discloses or suggests a disposable monolithic plastic support, as claimed.

It is therefore believed that the application is an allowable condition.

Favorable action is respectfully solicited.

While it is believed that the amended claims properly and clearly define the present invention, applicant would be open to any suggestion or amendment the Examiner may have or propose concerning different claim phraseology which, in the Examiner's opinion, more accurately defines the present invention.

Respectfully submitted,



Daniel O'BYRNE (Reg. No. 36,625)
Agent for the Applicant

Date: October 24, 2005
Address: Via Meravigli 16, 20123 MILAN-ITALY
Telephone: (from USA) (011)(39)(02)8590-7777
Telefax: (from USA)(011)(39)(02)863-860